

## REMARKS

Claims 32 and 35 have been amended. Claims 1 - 31, 33, 34 and 39 have been canceled. Thus, claims 32 and 35 - 38 remain pending in the present application. No new matter has been added. In view of the above noted amendment and the following remarks, it is respectfully submitted that all of the presently pending claims are in condition for allowance.

Claims 32, 36 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,423,830 to Schneebaum et al. ("Schneebaum") in view of U.S. Patent No. 5,336,252 to Cohen.

It is respectfully submitted that Schneebaum and Cohen fail to teach or suggest the step of "withdrawing the flexible cup into the lumen while maintaining vacuum pressure within the flexible cup to retain the severed tissue within the flexible cup," as recited in amended claim 32. Rather, the device of Schneebaum is only directed to leaving the web member 22 and sampled polyp PO distally of the endoscope insertion member 32 during removal from the body. (*See* Schneebaum, col. 5, ll. 43 - 50; col. 6, ll. 37 - 45; Figs. 3B, 3C, 5B, and 5C). Schneebaum does not teach or suggest that the web member 22 can be withdrawn into the biopsy channel 38. Rather, since the biopsy channel 38 comprises a significantly smaller diameter than the web member 22, it is respectfully submitted that Schneebaum is incapable of performing the recited step. Furthermore, it is respectfully submitted that the device of Schneebaum is incapable of being modified to meet the recited limitation. Specifically, Schneebaum does not teach or suggest that the web member 22 is retractable into the biopsy channel 38 after deployment. Furthermore, movement of the web member 22 back into the biopsy channel 38 would macerate the polyp PO, rendering the sample unsuitable for analysis while also preventing a full recovery thereof from the body. It is respectfully submitted that Schneebaum expressly teaches away from such a modification. (*See* Schneebaum, col. 1, ll. 41 - 63). It is therefore respectfully submitted that Schneebaum fails to teach or suggest the step of "withdrawing the flexible cup into the lumen while maintaining vacuum pressure within the flexible cup to retain the severed tissue within the flexible cup," as recited in claim 32 and that claim 32 is allowable over Schneebaum.

It is further submitted that Cohen also fails to teach or suggest the step of "withdrawing the flexible cup into the lumen while maintaining vacuum pressure within the flexible cup to retain the severed tissue within the flexible cup," as recited in amended claim 32. Rather, Cohen merely teaches a suction cup 92 adapted to be placed adjacent a target portion of the pericardium

to permit the attachment of electrical leads thereupon. (See Cohen, col. 4, ll. 33 - 51; col. 5, ll. 27 - 58; col. 11, ll. 50 - 61). Nowhere in the disclosure does Cohen teach or suggest any method wherein the suction cup 92 is retracted into the introducer 74 with a sampled portion of tissue therein. Cohen is not directed to severing any tissue at all since doing so would cause undue trauma to the heart. (See Cohen, col. 2, ll. 56 - 68).

Furthermore, it is respectfully submitted that Cohen is incapable of being modified to meet the limitation of "withdrawing the flexible cup into the lumen while maintaining vacuum pressure within the flexible cup to retain the severed tissue within the flexible cup," as recited in claim 32 since the folded configuration of the cup 92, as shown in Fig. 11, prevents the retention of any tissue therein. Specifically, the cup 92 must be returned to the folded configuration for insertion into the introducer 74, which has a smaller diameter than the cup 92. However, assumption of the folded configuration would not only damage any sampled tissue therein but would also eject most, if not all, of the sampled tissue thereoutof, thus rendering the modification unsatisfactory for its intended purpose.

It is therefore respectfully submitted that Schneebaum and Cohen, taken alone or in combination, fail to teach or suggest the step of "withdrawing the flexible cup into the lumen while maintaining vacuum pressure within the flexible cup to retain the severed tissue within the flexible cup," as recited in claim 32. It is respectfully submitted that claim 32 is therefore in condition for allowance. Because claims 36 and 37 depend from and therefore include all of the limitations of claim 32, it is respectfully submitted that these claims are also allowable.

Claims 35, 38 and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schneebaum in view of Cohen in further view of U.S. Patent No. 5,578,031 to Wilk et al. ("Wilk").

Amended claim 35 recites limitations substantially similar to claim 32, including a method for removing a selected portion of tissue from a surface of a body cavity, comprising the steps of "visually positioning the flexible cup adjacent to the selected portion of tissue by observing the selected portion of tissue at least partially through the flexible cup; applying a vacuum pressure to an interior of the flexible cup to draw the selected portion of tissue thereinto; fastening portions of tissue around a periphery of the selected portion of tissue; severing the selected portion of tissue from the surrounding tissue, wherein the portions of tissue around the periphery of the selected portion of tissue are fastened together by stapling; *withdrawing the*

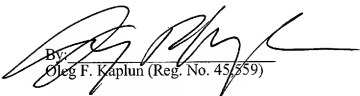
*flexible cup into the lumen while maintaining vacuum pressure within the flexible cup to retain the severed tissue within the flexible cup; and maintaining the selected portion of tissue within the flexible cup during withdrawal of the flexible cup from the body.”* As noted above, Schneebaum and Cohen fail to teach this limitation. It is further submitted that Wilk fails to overcome this deficiency. It is therefore respectfully submitted that Schneebaum, Cohen and Wilk, taken either alone or in any combination, fail to teach or suggest the recited limitations of claim 35 and that claim 35 is therefore in condition for allowance.

Claim 38 depends from and therefore includes all of the limitations of claim 32. As noted above, Schneebaum and Cohen fail to teach the recited limitations of claim 32. Wilk fails to cure this deficiency. It is therefore respectfully submitted that claim 32 is allowable over Schneebaum, Cohen and Wilk, taken alone or in any combination. It is further submitted that claim 38 is allowable as being dependent on an allowable base claim.

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Dated: April 14, 2009

By:   
Oleg F. Kaplun (Reg. No. 45,559)

Fay Kaplun & Marcin, LLP  
150 Broadway, Suite 702  
New York, New York 10038  
Tel: (212) 619-6000  
Fax: (212) 619-0276